

REMARKS

Claims 4, 5 and 7-9 are now pending in this application and are rejected. Claim 7 is objected to. Claim 8 is cancelled herein. Claims 1-3 and 6 were previously cancelled. New claims 10-19 are added herein adding additional structural limitations that further distinguish over the cited art. The new claims are supported by Figs. 1, 3 and 4 and the discussion in the Specification. Claims 4, 5, 7 and 9 are amended herein to clarify the invention and to address matters of form unrelated to substantive patentability issues. Other formal matters are attended to that were not addressed by the Examiner and accordingly are considered unrelated to substantive patentability issues.

Claims 4, 5, 7-9 are rejected under 35 U.S.C. §103(a) as obvious over Gupta et al. (U.S. Pat. No. 5,531,940) in view of the finite number of predictable solutions known in the art. More specifically, the Office Action states that Gupta discloses all the elements and claim limitations except it does not specifically disclose a small lens covered by a resin layer having a lower refractive index than the prepatory lens.

Applicant avers that the claims as amended overcome the rejection. Prior to the current amendment claim 7 recited that "the small lens is taken into the

integrated lens not to form a protruded surface.” This language was interpreted in the Office Action to mean that no portion of the small lens is uncovered or protrudes from the integrated lens. However, the intention of the Applicant was to recite that the small lens would not cause a protrusion to form on any external surface of the resulting bifocal lens. Moreover, such a structural feature clearly distinguishes the claimed bifocal lens from the one disclosed in Gupta. In all the bifocal lenses disclosed in Gupta, the bifocal segments (23), (33) & (52) produce a bulge or protrusion. The structure that covers the bifocal lens, including the bulging portions, are molds (22), (32) & (53) which are not part of the bifocal lens. Applicant has amended claim 7 to clarify the structure being claimed. Thus, the claim as amended is not sufficiently identical to the cited art to presume inherency of any structural limitation. Furthermore, the cited reference does not sufficiently evidence a recognized problem with a finite number of identified, predictable potential solutions where one of the solutions would result in the claimed bifocal lens.

In addition, Gupta does not disclose the curved surface as recited in the amended claim 4. The language of claim 4 has been amended to clarify the structure being claimed. In particular, the amended language clearly identifies the curved surface as the interface between the prepatory lens and the other resin

coating. Gupta neither discusses a lens nor do any of the figures in Gupta illustrate a lens with a bifocal portion having a chamfered peripheral edge with a curvature lower than other portions of the bifocal portion. More specifically, such a curvature along an interface between the lens preform (51) and the carrier layer (56) is clearly not disclosed. *See* Gupta Col 9. lines 47-50.

Even assuming, *arguendo*, that the interface is between the thin coat (58) and the bifocal segment (52) there is no evidence that Gupta discloses the claimed curved surface. Considering Gupta's lack of discussion on the transition between bifocal segment (52) and the lower portion of the carrier layer (56) it is likely that the interface by peripheral edge portion is not chamfered with a curved surface. Furthermore, no definitive determination can be made from Gupta's figures because the transition portion is not sufficiently enlarged. Thus, the claims as amended overcome the rejection for obviousness because the claimed structure has no protrusion and has a chamfered surface at the interface between the preparatory lens and the other resin by a peripheral edge of the small lens.

Claims 4 and 7 are rejected under 35 U.S.C. §103(a) as obvious over Nishikata et al. (U.S. Pat. No. 6,769,768) in view of Pandya (U.S. Pat. No. 6,934,084). More specifically, the Office Action states that Nishikata discloses all

the elements and claim limitations except it does not specifically disclose using a material with a high refractive index which is disclosed in Pandya. In addition, claims 4 and 7-8 are rejected under 35 U.S.C. §103(a) as obvious over Nishikata in view of Kosaka (U.S. Pat. No. 7,001,974). More specifically, the Office Action states that Nishikata discloses all the elements and claim limitations except for the casting and curing of the lens which the Office Action equates with the coating step disclosed in Nishikata and that the lens is made from an episulfide resin which is disclosed in Kosaka. Both of these rejections characterize the structure recited in the claims as simply the combining of prior art elements according to known methods to yield predictable results.

MPEP §2143 states that when rejecting a claim based on the rationale that the recited structure is simply “combining prior art elements according to known methods to yield predictable results” there must be a “finding that the prior art included each element.” In addition, there must be a finding that “each element merely performs the same function as it does separately.” In other words, to establish a *prima facie* case of obviousness, it is necessary to show that all the claim limitations are taught or suggested by the prior art. See *In re Royka and Martin*, 180 USPQ 580, 583, 490 F.2d 981 (CCPA 1974). Furthermore, “if [the] proposed modification would render the prior art invention being modified unsatisfactory for

its intended purpose, then there is no suggestion or motivation to make the proposed modification.” MPEP §2143.01 citing *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). The applicant respectfully asserts that the claims as amended overcome the rejection because the modification would render the cited art unsatisfactory for its intended purpose and the prior art fails to include each element as recited in the claims.

Claim 7 has been amended to specify that the prepatory lens is comprised of episulfide resin. Nishikata discloses a lens matrix (3) that is made of polyurethane with coating materials (8), (9) which are made of allyl diglycol carbonate resin. Nishikata col. 2 lines 63-65. The Office Action asserts that it would have been obvious to substitute episulfide resin for the polyurethane in the lens of Nishikata based upon the disclosure of Kosaka. However, it is known in the art that allyl diglycol resin will not adhere to the episulfide resin, as recited in the claim. Thus, substituting episulfide resin for the polyurethane in the lens of Nishikata would render the resulting lens unsatisfactory for its intended purpose.

In addition, Nishikata requires a coating material (9) on the concave side of the lens matrix (3). Nishikata’s structure does not provide for a semi-finish

lens that may be customized to a particular user. In contrast, the lens recited in the claims can be ground to adjust the corrective power of the lens.

Nishikata also does not disclose the curved surface as recited in the amended claim 4. Nishikata's specification provides no discussion on the interface surface by the peripheral edge of the near sight section (5). Furthermore, no definitive determination can be made from Nishikata's figures because the peripheral portion is not sufficiently enlarged. Thus, the claims as amended overcome the rejection for obviousness because modifying Nishikata as recited in the claims would render Nishikata unsatisfactory for its intended purpose, Nishikata does not provide the same function for the recited elements and there is insufficient evidence to establish that Nishikata discloses that the interface between the prepatory lens and the other resin by a peripheral edge of the small lens is chamfered with a curved surface.

Applicant submits herewith a substitute abstract wherein amendments are effected to place the text thereof into proper form in accordance with 37 CFR 1.72. No new matter is added. Entry of the substitute abstract is respectfully requested.

Applicant respectfully requests a two month extension of time for responding to the Office Action. The fee of \$460 for the extension is provided for in the charge authorization presented in the PTO Form 2038, Credit Card Payment form, provided herewith.

If there is any discrepancy between the fee(s) due and the fee payment authorized in the Credit Card Payment Form PTO-2038 or the Form PTO-2038 is missing or fee payment via the Form PTO-2038 cannot be processed, the USPTO is hereby authorized to charge any fee(s) or fee(s) deficiency or credit any excess payment to Deposit Account No. 10-1250.

In light of the foregoing, the application is now believed to be in proper form for allowance of all claims and notice to that effect is earnestly solicited.

Respectfully submitted,

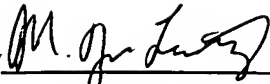
JORDAN AND HAMBURG LLP

By C. Bruce Hamburg *per [signature]*
C. Bruce Hamburg
Reg. No. 22,389
Attorney for Applicants

Docket No. F-8917

Ser. No. 10/559,803

and,

By 
M Zev Levoritz
Reg. No. 50,151
Attorney for Applicants

Jordan and Hamburg LLP
122 East 42nd Street
New York, New York 10168
(212) 986-2340

Enc: Form PTO-2038.